

1645

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Michael FAINZILBER et al.

Serial No. 09/210,952

Filed: 15 December 1998

For: GAMMA-CONOPEPTIDES



Examiner: L. Lee

Group Art Unit: 1645

RECEIVED  
MAY - 1 2000  
AC 1600 MAIL ROOM

#11 5/3/00  
TBray

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Office Action mailed 28 March 2000 setting forth a restriction requirement, Applicants elect to have the invention of Group I (claims 1-6) examined. This election is made with traverse.

It is urged that the Restriction Requirement set forth in the Office Action mailed 6 October 1999 correctly divides the claims of the present application, the division being I) claims 1-36 (now claims 1-10 and 12-36 because of the cancellation of claim 11) drawn to conopeptides and II) claims 37-47 drawn to nucleic acids encoding conopeptides. Because Applicants agree with the division between the peptide claims and the nucleic acid claims and because the nucleic acid claims are not being elected, the following sets forth Applicants' arguments concerning only the division of the peptide claims into different groups. Arguments concerning division of the nucleic acid claims are moot at this point and will not be presented here but will be presented in a divisional application if necessary.

There are two criteria for a proper requirement for restriction between patentably distinct inventions: 1) The inventions must be independent or distinct as claimed; and 2) There must be a serious burden on the examiner if restriction is not required. See MPEP § 803. Examiners must provide reasons and/or examples to support conclusions. For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant. Insofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria are set forth in MPEP § 803.02. See MPEP § 803. If the members of the Markush group are sufficiently few in number or so closely